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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,464	02/11/2004	Samuel Morgan Peters	2657U.000001	2237

21917 7590 12/15/2004

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EXAMINER

STERLING, AMY JO

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,464

Applicant(s)

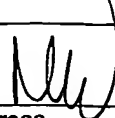
PETERS ET AL.

Examiner

Amy J. Sterling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the first Office Action for application number 10/777,464 Reinforced Rod Holder, filed on 2/11/04. Claims 1-18 are pending.

#### ***Information Disclosure Statement***

The information disclosure statement submitted on 2/11/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "socket is frusto conical" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities: The claim is improperly dependent upon itself. Appropriate correction is required. The claim were examined as if it were dependent upon claim 1.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 7, 8, 10, 14, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, line 2 recites the "centrally disposed opening" and it is unclear as to which central opening the claim refers. "A central opening" has been recited pertaining to the upper flange (See claim 1, line 7) and the backing plate (See claim 1, line 10).

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The claim was examined as if the term were referring to the upper flange central opening.

The term "highly" in claims 7 and 14 is a relative term which renders the claim indefinite. The term "highly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 8, recites the limitation "mounting flange" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 10 and 17, line 2 recites an "engagement receptacle" and it is unclear if this is the same element as cited in the specification, page 9 lines 13-16 as the "engagement lip".

Claim 18, recites the limitation "said fasteners" in line 4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

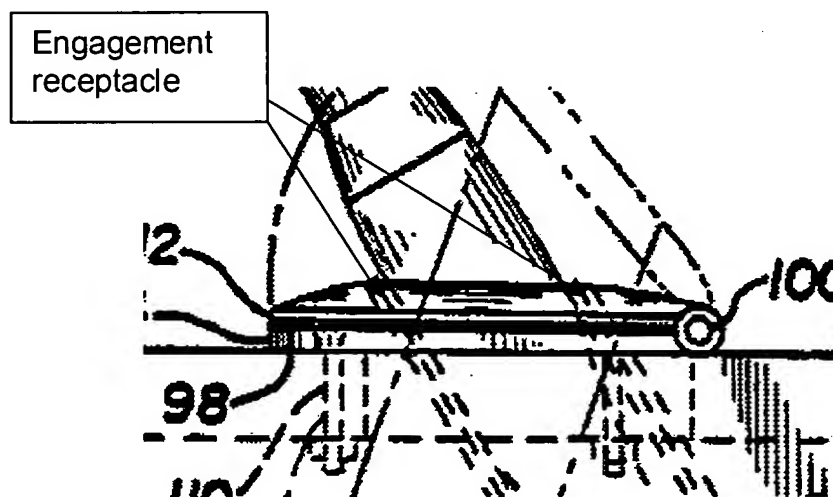
Claims 1-3, 5, 8-12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5163244 to Rupp and in view of United States Patent No. 5065540 to Potter, Jr.

Rupp discloses applicant's basic inventive concept, including a rod holder (2) assembly with concealed fasteners (32) having an upper flange (4) having a top surface and a lower surface with a centrally disposed tubular shaped opening therethrough, the upper flange having a perimeter edge spaced apart from the opening, a backing plate (16) (element 40 being shaped as a plate) having a centrally disposed opening, a receiving socket (20) having a tubular shaped open upper end, the socket being coupled to the backing plate and formed integral with the mounting flange and the backing plate, the receiving socket having an elongated lower end depending therefrom with a continuous sidewall between the upper end and the lower end, the sidewall having an inner surface dimensioned to approximate the opening of the top flange. Rupp also teaches a means for securing (12, 6) the backing plate to the upper flange wherein the upper flange is positioned on top of a boat gunnel mounting surface (30) and the backing plate is positioned beneath the mounting surface (30) and fastened to the upper flange (4). Rupp also teaches a stop member (18) positioned in the lower end of the receiving socket. Rupp does not teach a liner extending from the upper flange and extending into the receiving socket and the upper flange had an engagement receptacle to frictionally engage an edge of the liner.

Potter, Jr. teaches a rod holder (10) which has an upper flange (12, 14) and a receiving socket (30) which teaches a liner (35) which extends from the upper flange

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into the receiving socket, used to cushion the fishing rod handle during use, to prevent damage to the handle of the rod. Potter also teaches that the upper flange has an engagement receptacle (See Drawing Below), used for frictionally engaging the outer edge of the liner within the flange. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Potter, Jr. to have added a liner in order to prevent damage to the fishing rod, during use, and to have added an engagement receptacle in the upper flange in order to frictionally engage the outer edge of liner to the device.



Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5163244 to Rupp and in view of United States Patent No. 5065540 to Potter, Jr. as applied to claims 1 and 3 above and further in view of United States Patent No. 4578891 to Murray.

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Rupp and Potter, Jr. teach the basic inventive concept as shown above with the exception that they do not show that the receiving socket is frusto conical.

Murray shows a rod holding (3) which has a receiving socket which is frusto-conical (See Col. 2, line 8), the shape used so that the rod rests at an angle while inserted in the receiving socket. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Murray to have included a frusto-conical shaped receiving tube in order to have the rod rest at an angle.

Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5163244 to Rupp and in view of United States Patent No. 5065540 to Potter, Jr. as applied to claims 1, 5 and 12 above and further in view of United States Patent No. 3964706 to Adams.

Rupp and Potter, Jr. teach the basic inventive concept as shown above with the exception that they do not specifically show that the stop member is rotatable.

Adams teaches a rod holder, having a receiving socket (44') with a rotatable stop member (74, 78, 80, See Fig. 12), the stop member being inherently rotatable in that it can be easily removed from the holder (44', See Col. 6, lines 23-30), thereby the stop member is not adhered to the surface of the device in order to make it immovable, the rotation of the pin being used so that the leaning direction of the rod may easily changed from one side of the receiving socket to the other, in order to fish on the opposite side of the boat, without removing the rod from the rod holder. Therefore, it



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would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Adams to make the stop member rotatable in order to easily change the position of the rod, without removing the rod from the device.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5163244 to Rupp and in view of United States Patent No. 5065540 to Potter, Jr. as applied to claims 1 and 12 above and further in view of United States Patent No. 4551939 to Kitchens.

Rupp and Potter, Jr. teach the basic inventive concept as shown above with the exception that they do not specifically show that the upper flange is highly polished.

Kitchens teaches a rod holder (19) which is made of polished aluminum (See Col. 3, line 30 for material selection), the polishing used for its aesthetic appeal.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Kitchens to have selected a polished material, in order to have an aesthetically pleasing device.

#### ***Allowable Subject Matter***

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The reason is that the prior art does not teach at least one fastener boss receptive to a fastener bolt inserted through a slotted aperture in the backing plate. Although the term "receptive to a fastener bolt" was considered as a functional statement only and not a positive limitation, the Rupp and Potter, Jr. references as combined are not capable of accepting a fastener through an aperture in the backing plate, the acceptance of the bolt into the boss, which would fixedly attach the backing plate and the upper flange to each other in a manner that would not allow the elements to rotate relative to each other. Modifying the device as such would destroy the intended purpose of the device.

Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The reason is that removing a fastener to remove the upper flange without disturbing the receiving socket is not possible since the receiving socket, which is attached to the backing plate, is suspended by the upper flange, so the removal of the upper flange will inherently disturb the receiving socket.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The following documents show various cylindrical holders

6643974 to Ruiz et al.

5322254 to Birkmeier


4375731 to Budd

4235409 to Cummings

602662 to Miller

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for the Technology center is 703-872-9306 (formal amendments) or 703-308-3519 (informal amendments/communications).

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.

  
Amy J. Sterling  
12/10/04